

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants:	Luis E. LUCIANI, JR. et al.	§	Confirmation No.:	9421
		§		
Serial No.:	10/728,465	§	Group Art Unit:	2451
		§		
Filed:	December 5, 2003	§	Examiner:	K. Q. Dinh
		§		
For:	Method and System For	§	Docket No.:	200314490-1
	Switching Between	§		
	Remote Console Sessions	§		

REPLY BRIEF

Mail Stop Appeal Brief – Patents

Date: August 16, 2010

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Supplemental Answer of June 16, 2010, Appellants present this Reply Brief.

I. NEW SECTION 112, FIRST REJECTION

The Supplemental Examiner's Answers presents a new Section 112, First rejection of claims 14-17 and 20, based on claim 14 having a single means-plus-function limitation. Appellants respectfully traverse.

In particular, the Supplemental Answer indicates, "A single means claim covers every conceivable means for achieving the stated result while the specification discloses at most only those means known to the inventors."¹ The Answer assumes that the claim cover every "every conceivable means"; however, such an assumption is not valid, particularly in view of the language of the statute. More particularly, 35 USC § 112, Sixth reads:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim **shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.**²

¹ Supplemental Answer dated June 16, 2010, Page 3, first full paragraph.

² 35 USC § 112, Sixth paragraph (emphasis added).

Appellants respectfully submit that a claim written in means-plus-function format cannot, by its very nature, cover “every conceivable means.” The express wording of the statute indicates such a claim covers **only** “the corresponding structure, material, or acts described in the specification and equivalents thereof.” For this reason alone the rejection should be overturned and the claims set for issue.

Moreover, the statutory equivalency afforded a means-plus-function limitation extends only to structures available at the time of issuance.³ For a means-plus-function claim to cover “every conceivable means” requires an assumption, clearly in error, that there is no further innovation possible in this realm – that every possible implementation to perform the claimed function is either expressly described or is an equivalent. The Answer makes no such finding, and thus the position that the claim covers “every conceivable means” is clearly in error. For this additional reason the rejection should be overturned and the claim set for issue.

Further still, MPEP 2164.08(a) is only applicable to claims with a single means;⁴ however, to apply the “rule” of MPEP 2164.08(a) is to elevate form over substance. In particular, the notion that had Appellant included another (even structurally insignificant) limitation in representative claim 14, by some mechanism the breadth of the limitation at issue would change, is simply without merit. The limitation, by operation of codified statutory law, covers “the corresponding structure, material, or acts described in the specification and equivalents thereof,” and the presence or absence of a second limitation in the claim does not change the scope of the claim.

³ *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc.* 145 F.3d 1303 (Fed. Cir. 1998); *Medtronic MiniMed, Inc. v. Smiths Medical MD Inc.* 373 F.Supp.2d 466, 470 (D. Del. 2005) (“A structural equivalent under section 112, paragraph 6, must have been available at the time the claim issued.”)

⁴ MPEP 8th Ed., Rev. 6, September 2007, Section 2164.08(a).

Based on the foregoing, Appellants respectfully submit that claims 14-17 and 20 do not suffer under Section 112, First based on claim 14 having a single means-plus-function limitation.

II. CONCLUSION

It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,

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